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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/209,454 | 12/11/1998 | HIDENARI TANAKA | 88125/ASAHIIN | 6958 |
| 23548 | 7590 | 11/10/2003 | EXAMINER | |
| LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960 | | LASTRA, DANIEL | | |
| | | ART UNIT | | PAPER NUMBER |
| | | 3622 | | |

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/209,454 | TANAKA ET AL. | |
| | Examiner | Art Unit | |
| | DANIEL LASTRA | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 17-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Claims 17-21 have been examined. Application 09/209,454 has a filing date 12/11/1998 and foreign priority date 12/12/1997.

Response to Amendment

2. In response to the Official Action mailed May 22, 2003, Applicant amended claims 17 and 19 and added claim 21.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201).

As per claim 17, Pauly et al teach:

A method of selling prescription contact lenses using a system comprising a first group information processing apparatus and a plurality of second group information processing apparatus, connected through a communication network, both the first group information processing apparatus and the plurality of second group information processing apparatus writing data on respective recording media and reading the data

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from the respective recording media, each recording medium being used by only one corresponding customer, said method comprising:

transferring customer identification, address, and diagnostic data pertaining to a respective customer from said plurality of second group information processing apparatus located at offices of respective optical care providers to said first group information processing apparatus located at a contact lens provider through the communication network (see column 2, line 35 – column 3, line 5; column 3, line 36 – column 4, line 38; column 5, lines 4-18; column 6, lines 11-33);

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the provider (see column 6, lines 39-45);

Pauly fails to teach:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network;

delivering a contact lens from the selling agent to the customer; and

transferring delivery data from the selling agent to the contact lens provider through the communication network.

However, Fay teaches:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address

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data, from the contact lens provider to the customer, through the communication network (see column 5, line 55 – column 6, line 54);

delivering a contact lens from the selling agent to the customer (see column 6, lines 35-54); and

transferring delivery data from the selling agent to the contact lens provider through the communication network (see column 6, lines 48-54).

Although the Fay system relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other related products (see column 9, lines 4-8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly system would deliver the purchase product, in this case contact lenses, to a selling agent that would take care of delivering the product to the customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), the customer would go to that store to pick up the product and this way he/she would save the shipping and handling charges.

As per claim 18, Pauly teaches:

The method of Claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens provider to the customer through the communication network (see column 1, lines 46-65; column 7, lines 9-21).

As per claim 19, Pauly does not expressly teach:

The method of Claim 17, including offering new contact lenses to the customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of

the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a monthly payment by the customer. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where it would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if for whatever reason the patient breaks a contact lens or scratches it, even though he/she is not scheduled to receive new contact lenses, he/she may choose to get them out of schedule because out of convenience, his or her preference and/or the better quality of vision provided by the contacts.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of the article Cashing in on quicker delivery times .

As per claim 20, Pauly fails to teach the method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens provider to the customer through the communication network. However, the article Cashing in on quicker delivery times teaches about a system where the contact lens provider offers to its customers 99.99 percent on-time delivery of its product when using the contact lens provider ordering network and offers customers the option of ordering product direct from local distributors (see paragraphs 3-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would receive products updates periodically, as taught by the article.

This feature would give customers a reliable venue to obtain the products related to their contact lens care.

As per claim 21, Pauly teaches:

The method of claim 19, including contracting for a one year term with the respective customer for supplying long-term-use contact lenses in exchange for the old contact lenses and the monthly payment (see column 7, lines 9-48).

Response to Arguments

4. Applicant's arguments filed 08/19/03 have been fully considered but they are not persuasive. The Applicant mentioned regarding claim 17 that the apparatus in the two groups differs because the apparatus of the second group can write data on and read data from a recording medium, for example a credit-card size device. The Applicant mentioned that the first group information processing apparatus processes and controls data, assigns registration numbers to contact lens wearer based upon the data and records various data, including registration number, on the recording medium for corresponding contact lens wearer.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which the Applicant relies (i.e., recording medium) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specifications are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no mention in the embodiment of claim 17 that the apparatus in the two groups differs because the apparatus of the second group can write data on and

read data from a recording medium, for example a credit-card size device. The embodiment of claim 17 only describes a first and a second group information processing apparatus. Thus, the Applicant's arguments are not persuasive.

Again with regards to claim 17, the Applicant argues that because of the general interconnection between the two groups of information processing apparatus, the contact lens wearer who has been issued a medium containing information pertaining to his or her own needs can easily change practitioners providing eye care, all of whom are part of the system, without loss in continuity of treatment. The Applicant mentions that, in other words, the user can readily change the ophthalmologist or optometrist consulted with respect to contact lens diagnosis.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., change practitioners providing eye care without loss in continuity of treatment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 17 recites "transferring customer identification, address, and diagnostic data pertaining to a respective customer from *said plurality of second group information processing apparatus located at offices of respective optical care providers to said first group information processing apparatus located at a contact lens provider through the communication network*; assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and

diagnostic data transferred to the provider; providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network; delivering a contact lens from the selling agent to the customer; and transferring delivery data from the selling agent to the contact lens provider through the communication network". Nowhere in claim 17 is it mentioned that the user can readily change the ophthalmologist or optometrist consulted with respect to contact lens diagnosis and prescription needs.

The Applicant also argues that claim 17 includes a medium with unique data for each contact lens wearer, i.e. customer, so that the customer can contract for contact lens supply and can consult with any of the optical care personnel who participate in the contact lens selling system for care and that neither Pauly and Fay disclose this feature.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies (i.e., contract) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no mention in Claim 17 that the customer has a contract for contact lens supply. Claim 17 only describes the transferring and delivering of data between customers, optical care providers, contact lens provider and selling agent.

With regard to claim 19, the Applicant argues that Pauly or Steltzer requires a regular periodic distribution of contact lenses to contact lens users. By contrast, the

system described in claim 19 provides for irregular distribution of contact lenses based upon irregular events that may occur.

The Examiner answers that although Pauly does not expressly teach claim 19, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where he or she would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if for whatever reason the patient breaks a contact lens or scratches it, even though he/she is not scheduled to receive new contact lenses, the customer would choose to get them out of schedule out of convenience, his or her own preference and/or the better quality of vision provided by contact lenses.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

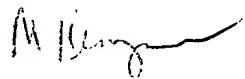
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.L.

Daniel Lastra
October 17, 2003



MELANIE A. KEMPER
PRIMARY EXAMINER